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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/034,058 | 12/27/2001 | Timothy Craig Ostwald | 2001-080-TAP | 1826 |

7590 10/19/2004
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EXAMINER

RENNER, CRAIG A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2652

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,058

Applicant(s)

OSTWALD ET AL.

Examiner

Craig A. Renner

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10 and 12-26 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 22-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 and 12-21 is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 7 is/are rejected.
- 7) ☒ Claim(s) 3 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All -- b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claim 8 is generic and allowable over the prior art of record. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claim 12, directed to the species of FIG. 6, is no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claims 2 and 24 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to one or more non-elected inventions/species, since these claims do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141. Applicant timely traversed the restriction (election) requirement in the reply filed on 18 December 2003.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

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2. Claims 22-23 and 25-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 23 March 2004.

Drawings

3. The drawings were received on 12 July 2004. These drawings are accepted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Munro et al. (US 4,945,429).

Munro teaches a data storage library (Fig. 2, for instance) comprising first (left portion of 202, for instance) and second (right portion of 202, for instance) arrays of storage cells, the storage cells in the first and second arrays being operable to receive data storage elements, the first and second arrays describing an interior space between the first and second arrays (as shown in Fig. 2, for instance); and a third array of storage cells (201), the storage cells in the third array being operable to receive data

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storage elements, the third array being substantially located within the interior space (as shown in Fig. 2, for instance); wherein a robotic picker (240) is translatable along a path (between 201 and 202), the path located within the interior space (as shown in Fig. 2, for instance); wherein the path has sections adjacent to each storage array of the library such that the robotic picker can access any storage array by translating to it along the path (as shown in Fig. 2, for instance) [as per claim 1]; wherein when the robotic picker is positioned to access a storage element of the first array, it can rotate so as to access a storage element of the third array (as shown in Fig. 4, for instance) [as per claim 4]; and wherein the data storage elements are selected from the group consisting of magnetic tape cartridges, floppy disks, hard disks, and compact disks (lines 7-10 in column 1, for instance, i.e., magnetic tape cartridges) [as per claim 7].

Allowable Subject Matter

6. Claims 8-10 and 12-21 are allowable over the prior art of record. Claims 3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.


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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (703) 308-0559. The examiner can normally be reached on Tuesday-Friday 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Craig A. Renner
Primary Examiner
Art Unit 2652

CAR